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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/839,141	04/23/2001	Shuichi Shiitani	1359.1044	1624

21171 7590 02/27/2007
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EXAMINER

GART, MATTHEW S

ART UNIT	PAPER NUMBER
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3625

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
3 MONTHS	02/27/2007	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

Office Action Summary

Application No.

09/839,141

Applicant(s)

SHIITANI ET AL.

Examiner

Matthew S. Gart

Art Unit

3625

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 December 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 and 17-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 and 17-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date: _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Prosecution History Summary

- Claims 1-10 and 17-25 are pending in the instant application.
- Claims 11-16 were previously canceled.
- Claim 25 has been added per the applicant's response filed 12/1/2006.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim 25 is rejected under 35 U.S.C. 101.

Referring to claim 25. Claim 25 does not provide a practical application that produces a useful result. For an invention to be "useful" it must satisfy the utility requirement of section 101. The USPTO's official interpretation of the utility requirement provides that the utility of an invention has to be (i) specific, (ii) substantial and (iii) credible. MPEP § 2107.

The preamble of claim 25 sets forth an online shopping method. The body of the claim is absent of any active process steps that results in a practical application that produces the result of online shopping,

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-10, 17-22 and 25 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Referring to claims 1-10. Claim 1 was amended to set forth that said article picture arrangement data being independent of the data sending rank. The examiner notes in the "upon receiving" step of claim 1 the article picture arrangement data is dependent upon the data sending rank. It is unclear on how the article picture arrangement data can be independent of the data sending rank, when it was previously dependent upon the data sending rank. Claims 2-10 are dependent upon claim 1 and acquire the deficiencies of claim 1.

Referring to claims 17-20. Claims 17-20 are rejected under the same rationale as set forth above in claims 1-10.

Referring to claims 21-22. Claims 21-22 are rejected under the same rationale as set forth above in claims 1-10.

Referring to claim 25. Claim 25 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the

Art Unit: 3625

subject matter which applicant regards as the invention. The preamble of claim 25 purports the utility of "shopping," but the body of the claim is not commensurate with the scope of the preamble, and does not provide the active steps of "shopping" necessary to achieve the purported utility.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-10 and 17-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Maes (U.S. Patent Application Publication No. 2002/0002502) in view of Shultz (U.S. Patent Application Publication 2003/0061211).

Referring to claims 1. Maes discloses an online shopping method, comprising:

- Previously generating/preparing article data in which features of an article picture and a data sending rank are related to each article picture as additional information (Maes: paragraph 0048 through paragraph 0050 and paragraph 0057 through paragraph 0059);
- Upon receiving an article search by a user, generating article picture arrangement data of all search resultant article pictures in which similar features of the search resultant article pictures are disposed on a two-dimensional plane (Maes: paragraph 0051 through paragraph 0052 and paragraph 0059);
- Sending the article picture arrangement data to a user terminal (Maes: paragraph 0051 through paragraph 0052 and paragraph 0059), said article picture arrangement data being independent of the data sending rank; and

Art Unit: 3625

- At the user terminal, displaying each of the search resultant article picture at each arrangement position on a screen of search results in a receiving order (Maes: paragraph 0054 through paragraph 0055).

Maes does not expressly disclose an online shopping method, comprising:

- Upon receiving an article search by a user, the more similar the results are in the features, the more closely the results are disposed and sending the search resultant article pictures in accordance with the data sending rank ;
- Sending the search resultant article pictures in accordance with the data sending rank; and
- At the user terminal, displaying each of the search resultant article picture at each arrangement position in accordance with the article picture arrangement data on a screen of search results in a receiving order, thereby displaying an article picture with a higher data sending rank earlier at the arrangement position.

Shultz discloses an online shopping method, comprising:

- Upon receiving an article search by a user, the more similar the results are in the features, the more closely the results are disposed and sending the search resultant article pictures in accordance with the data sending rank (Shultz: paragraph 0060);
- Sending the search resultant article pictures in accordance with the data sending rank (Shultz: paragraph 0061); and

Art Unit: 3625

- At the user terminal, displaying each of the search resultant article picture at each arrangement position in accordance with the article picture arrangement data on a screen of search results in a receiving order (Shultz: paragraph 0061) thereby displaying a result with a higher data sending rank earlier at the arrangement position (Shultz: paragraph 0061).

The Examiner notes, Shultz discloses a method wherein information may subsequently be sorted according to user preference and/or a predefined search result sorting routine. Such sorting may pertain to specific sorting criteria, for example, by order of importance, relevance or hierarchy of the information retrieved from database 133. Example sorting criterion might include, a distance from the user identified location (e.g., step 232), corresponding advertising information (e.g., step 234) and/or business information (e.g., step 236). Business information may be sorted according to various criteria, for example, alphabetical criteria, such as by the name of the business, size criteria, such as the size of the business, price criteria, time criteria, event criteria, or any other sorting criteria that might be helpful to a user (Shultz: paragraph 0060). At the time of the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of Maes to have included the teachings of Shultz because, unfortunately conventional search engines often return a wide range of unusable search results (Shultz: paragraph 0006).

Referring to claim 2. Maes further discloses an online shopping method wherein the features of the article picture arrangement data is generated in accordance with a combination of a similarity of a feature of each resultant article picture and at least one selected from the group consisting, a keyword representing the feature of the article, and article classification information regarding classification of the article in accordance with the features thereof, or a combination thereof (Maes: paragraph 0048 through paragraph 0052).

Referring to claim 3. Maes further discloses an online shopping method wherein the data sending rank is determined by an article provider (Maes: paragraphs 0050).

Referring to claim 4. Maes further discloses an online shopping method wherein a service user previously selects items to be considered in purchasing an article and notifies a service provider of the selection, and the service provider determines the data sending rank in accordance with the notified items (Maes: paragraph 0054).

Referring to claim 5. Maes further discloses an online shopping method wherein a service provider previously analyzes items considered by a service user based on a past search history and a past purchase history of the service user, and the service provider determines the data sending rank in accordance with the analyzed items (Maes: paragraph 0097).

Art Unit: 3625

Referring to claim 6. Maes further discloses an online shopping method wherein a screen of article search results is presented to an article provider, and the article provider specifies a picture of an article which the article provider provides on the presented screen of article search results, thereby making it possible to access selling information of the article (Maes: Figure 3 through Figure 6).

Referring to claim 7. Maes further discloses an online shopping method wherein the data sending rank is determined by an article provider ((Maes: paragraph 0048 through paragraph 0052).

Referring to claim 8. Maes further discloses an online shopping method wherein a service user previously selects items to be considered in purchasing an article and notifies a service provider of the selection, and the service provider determines the data sending rank in accordance with the notified items (Maes: paragraph 0054 through paragraph 0055).

Referring to claim 9. Maes further discloses an online shopping method wherein a service provider previously analyzes items considered by a service user based on a past search history and a past purchase history of the service user, and the service provider determines the data sending rank in accordance with the analyzed items (Maes: paragraph 0097).

Referring to claim 10. Maes further discloses an online shopping method wherein a screen of article search results is presented to an article provider, and the article provider specifies a picture of an article which the article provider provides on the presented screen of article search results, thereby making it possible to access selling information of the article (Maes: Figure 3 through Figure 6).

Referring to claims 17-20. Claims 17-20 are rejected under the same rationale as set forth above in claims 1-10.

Referring to claims 21-22. Claims 21-22 are rejected under the same rationale as set forth above in claims 1-10.

Referring to claim 23. Claims 23 is rejected under the same rationale as set forth above in claims 1-10.

Referring to claim 24. Claims 24 is rejected under the same rationale as set forth above in claims 1-10.

Referring to claim 25. Claims 25 is rejected under the same rationale as set forth above in claims 1-10.

Response to Arguments

Applicant's arguments filed 12/01/2006 with respect to the pending claims were considered but are not persuasive.

The Applicant argues that in contrast to Maes and Shultz, according to the claimed invention, pictures are transmitted in accordance with the data sending rank, irrespective of the arrangement of pictures.

The Examiner notes, Maes discloses a method that facilitates user selection of one or more products (STEP 101). One or more products, often several products, are presented to a user. In the first iteration of the method, a random or predetermined selection of products from the product space can be presented to the user (Maes: paragraph 0051). During this random presentation, the pictures are transmitted in accordance with the data sending rank, irrespective of the arrangement of pictures.

The Applicant further argues that Maes and Shultz does not teach or disclose displaying similar search resultant article pictures as an initial search result where the more similar features of the search resultant pictures are disposed closely.

The Examiner notes, Shultz discloses a method wherein information may subsequently be sorted according to user preference and/or a predefined search result sorting routine. Such sorting may pertain to specific sorting criteria, for example, by order of importance, relevance or hierarchy of the information retrieved from database 133. Example sorting criterion might include, a distance from the user identified location

Art Unit: 3625

(e.g., step 232), corresponding advertising information (e.g., step 234) and/or business information (e.g., step 236). Business information may be sorted according to various criteria, for example, alphabetical criteria, such as by the name of the business, size criteria, such as the size of the business, price criteria, time criteria, event criteria, or any other sorting criteria that might be helpful to a user (Shultz: paragraph 0060). At the time of the invention was made, it would have been obvious to a person of ordinary skill in the art to have modified the system of Maes to have included the teachings of Shultz because, unfortunately conventional search engines often return a wide range of unusable search results (Shultz: paragraph 0006).

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Matthew S. Gart whose telephone number is 571-272-3955. The examiner can normally be reached on M-F, 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jeff Smith can be reached on 571-272-6763. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Art Unit: 3625

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MSG

Primary Examiner

February 8, 2007


MATTHEW S. GART
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